

Utility Patent
Ser. No. 10/649,691

REMARKS

The *Ex parte* David Maniaci decision made by the Board of Patent Appeals and Interferences on July 25th, 2008 has been reviewed. Claims 1-6 were pending on appeal. The Board affirmed the rejections of claims 3-6 under 35 U.S.C. §103(a), reversed the rejection of claims 1 and 2 under 35 U.S.C. §103(a), and set forth a new ground of rejection of claims 1 and 2 under 35 U.S.C. §103(a). No Claims are amended. No new matter is introduced.

Claim Rejections - 35 USC § 103

The Board of Patent Appeals and Interferences rejects Claims 1-2 under 35 U.S.C. § 103(a), as obvious over Mann (U.S. Des. Pat. No. 351,316) in view of Cancr (U.S. Des. Pat. No. 242,106), Brundage (U.S. Pat. No. 3,955,672), and Perlis et al. (Perlis hereinafter) (U.S. Pat. No. 5,803,305).

The Board substantially supports the Examiner's arguments used in the final office action that was ultimately reversed. Namely, the Board maintains that Mann teaches the present invention but for (1) the partition element having a flat upper apex that transitions smoothly to the plate support surface, (2) a cup retaining orifice formed on the plate support surface, and (3) a stiffened cup support rim circumscribing the cup retaining orifice.

Applicant respectfully disagrees that the Board has shown that the combination of the applied references teaches *each* and *every* element of the claimed invention. For a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. MPEP § 706.02(j). Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v.

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United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

With regards to the independent claim 1, the Board argues that the a pair of partition elements connects at a centerpoint of the plate support surface; however, it should be noted that what can be interpreted as a "pair of partition elements" in Mann does not connect at the centerpoint of the plate support surface. Rather, the partition elements connect at the top plane formed by the circular outer flange rim that is substantially elevated above the plate support surface. It cannot be ascertained from the illustrations in Mann whether these partitions connect at the centerpoint of the outer flange plane. Moreover, since the partitions do not extend to the plate support surface, it cannot be ascertained whether they connect at the centerpoint of the plane formed by the plate support surface.

Further with respect to the partitions, the Board argues that Caner teaches a partition element having a flat upper apex that transitions smoothly to the elevation of the plate support surface by a curving partition sidewall having similar curvature with the upwardly curving peripheral rim (FF 14). It should be noted that in the brief description of the invention, Caner teaches that the partition element comprises "downwardly and outwardly inclined straight sides" with the ends of the T-section flowing through concave arcs. It is apparent that the straight sides

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taught by Caner do not meet the limitation of a curving sidewall. Wherein the cited art only has a curving sidewall in the corner sections, the present invention comprises a continuous curving partition sidewall. Applicant contends that the Board has not shown that the combination of the two references teaches a continuous curving partition sidewall.

Additionally, Applicant contends that Mann does not teach a third partition element, nor does it offer any suggestion or motivation why one could be incorporated. In Mann, the two partition elements extend radially from the periphery of the circular flange rim to the cup support rim. The present invention teaches that the third partition element connects the cup support rim with the apex of other partition elements.

Further with respect to claim 1, the Board supports the Examiner's contention that the incorporation of Caner's partition sidewalls with Mann's partition elements would significantly reduce stress concentrations. Neither of the two references suggests any motivation why it would be desirable to have partition sidewalls that provide smooth transitions to the plate support surface. Additionally, Caner does not disclose that the straight sides provide any improvement in stress concentration. From a strength of materials point of view, having partition sidewalls would not reduce stress concentrations at either the plane of the plate support surface or the plane of the partition elements. Rather, the partition sidewalls would increase the resistance to bending about the plane of the plate support surface. This, in turn, would lead to *increased* stress concentration at the mating points between the plate support surface and the partition sidewalls since the stress would not be evenly distributed along the periphery of the plate support surface. The only instance where stress concentration would be improved is with the buckling of the peripheral rim which connects the plate support surface and the outer flange; however, plates of this kind are normally not subjected to buckling and therefore there would be no motivation to reduce

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buckling stress concentration.

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art, the Examiner's or the Board's arguments that would suggest the desirability or obviousness of making a third partition element according to the present invention. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The Examiner and the Board seem to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

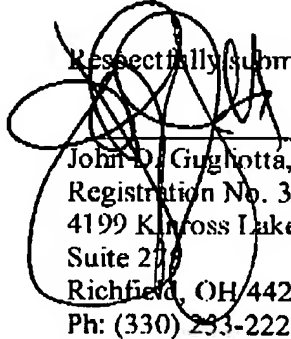
Accordingly, withdrawal of the rejections is respectfully requested.

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CONCLUSION

In view of the amendments submitted herein and the above comments, it is believed that all of the grounds of rejection are overcome and that the application is now placed in full condition for allowance. Should there be any further questions, Examiner is urged to telephone Applicants' undersigned attorney at (330) 253-2225.

Respectfully submitted,



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